

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/083,249 Confirmation No.: 8236
Applicants : Joseph A. GIORDANO, et al.
Filed : February 27, 2002
Title : SYSTEM AND METHOD FOR PROCESSING FINANCIAL
TRANSACTIONS
TC/Art Unit : 3628
Examiner: : Clement B. GRAHAM
Docket No. : 24124.000172

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over five years ago on February 27, 2002. On July 6, 2005, an initial Office Action was issued, rejecting claims 1-49 under 35 U.S.C. § 103 as being allegedly unpatentable over U.S. Patent No. 6,195,541 to Griffith in view of U.S. Pub. No. 2001/001129 to Anderson et al. ("Anderson"). On January 6, 2006, Applicants timely filed a responsive amendment to the Office Action, cancelling approximately two-thirds of the pending claims without prejudice in order to expedite prosecution, and argued against the rejection. On April 6, 2006, the Office found Applicants amendments/arguments persuasive and issued a new rejection based on alleged anticipation by U.S. 6,089,284 to Kaehler et al. ("Kaehler") under 35 U.S.C. § 102(e). Despite various clarifying amendments to the claims to distinguish this application from that of the cited reference, the Office finally rejected the claims on December 15, 2006, maintaining the same rejection.

Independent claim 11 has been previously amended to recite “wherein the loyalty award program data comprises a loyalty award amount that is redeemable with a merchant other than a merchant associated with the merchant identifier.” In one embodiment of the invention, the transaction processing system may have an association with a plurality of different merchants to allow a merchant associated with the system to couple its incentive program with that of another participating merchant. Such a system may allow customer loyalty to be awarded across multiple merchants. *See, e.g.,* Specification at 7:4-7.

Kaehler does not teach or suggest the recited loyalty award program data. Rather, Kaehler only teaches one merchant where a loyalty award that may be redeemed only at the merchant’s point-of-sale. Such a loyalty award is therefore, not redeemable with a merchant other than a merchant associated with the merchant identifier.

The Office, however, alleges that it is “inherently clear” that Kaehler teaches the claimed features, specifically alleging that “Kaehler[] discloses loyalty benefits and fueling environment or one of an associated groups of environments and redeeming loyalty benefits at the same or an associated fueling environments *which can be one of many a franchises own by a different person/s or entities.*” *See* Office Action at p. 6 (emphasis added). Applicants respectfully disagree. Nowhere in Kaehler is such a disclosure found. In fact, Kaehler’s loyalty benefits merely “encourage **subsequent** return.” In other words, Kaehler’s loyalty benefits encourage customers to return to the same merchant at either “the same or an associated fueling environment.” *See* Kaehler at col. 14, lines 55-57; col. 15, lines 1-13. This is clearly distinguishable from the loyalty program having loyalty award amounts redeemable with merchants “other than a merchant associated with the merchant identifier,” as expressly recited in claim 11.

Accordingly, Kaehler does not anticipate or render obvious claim 11. Applicants therefore respectfully submit that claim 11 is allowable over Kaehler.

Claims 13-20, 50 and 51 depend from allowable claim 11 and are therefore allowable for at least that reason.

Independent claims 21 and 24 recite a method for enrolling users in a transaction processing program. Specifically, claims 21 and 24 recite “enrolling a user associated with the customer transponder by storing enrollment data comprising said associated transmitter identification data and said payment information in said host transaction processing system.”

Kaehler does not teach any method for enrolling users in a transaction program, much less the recited method for enrolling users in a transaction processing program.

Accordingly, Kaehler does not anticipate or render obvious claims 21 and 24. Applicants therefore respectfully submit that claims 21 and 24 are allowable over Kaehler.

Claims 22-23 and 25-26 depend from either independent claim 21 or 24 and are therefore allowable for at least that reason.

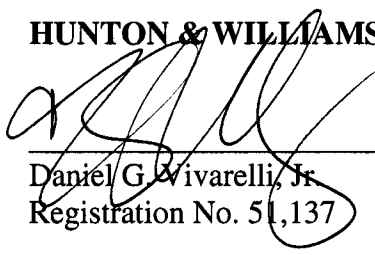
Therefore, because Kaehler fails to teach each and every claimed limitation as required by section 102, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by ExxonMobil Corporation when the grounds is so clearly improper.

Respectfully submitted,

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Dated: May 14, 2007

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